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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,068	05/31/2001	Brian K. Courtney	MAC1001U	1810

34313 7590 10/15/2004

ORRICK, HERRINGTON & SUTCLIFFE, LLP  
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SUITE 1600  
IRVINE, CA 92614-2558

EXAMINER

HAYES, MICHAEL J

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/872,068	COURTNEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael J. Hayes	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-17,34-38,40-45 and 67-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-17,34-38,40-45 and 67-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/11/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/08/04 has been entered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 9, 10, 13, 15, 34, 35, 40, 44, 45, 67-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Dubrul (US Patent No. 6,287,271). Dubrul discloses a catheter having an outer shaft, expandable occluder, efflux port in communication with outer shaft lumen, inner shaft, influx port in fluid communication with inner shaft lumen, treatment port for access to outer shaft lumen, means for varying fluid flow rates through the ports and within the patient's vessel, guidewire in the inner shaft lumen, a source of contrast fluid, and a filter positioned through the treatment port. See figs. 12-18.

Claims 1, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by CONSTANTZ et al. (US Patent No. 6,527,979). Constantz discloses a catheter having an outer

Art Unit: 3763

shaft, expandable occluder, efflux port in communication with outer shaft lumen, inner shaft, influx port in fluid communication with inner shaft lumen, treatment port for access to outer shaft lumen, and a balloon catheter that is capable of delivering a stent or performing angioplasty. See figs. 3b, 4b.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 6, 7, 8, 37, 38, 41, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubrul as applied to claims 1 and 34 above, and further in view of DAVIS et al. (US Patent No. 6,068,608. Dubrul discloses the claimed invention except for inflation passage in wall or separate shaft, occluder of open-cell foam enclosed by sheath. Davis teaches the use of an inflation passage in wall and occluder of open-cell foam enclosed by sheath to isolate a volume within a patient to facilitate surgery and therapeutic treatment. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Davis in the catheter of Dubrul to occlude body passageways of varying diameters and to have the occluder expand using minimal catheter width. The separation of the inflation lumen from the wall would be obvious to one of ordinary skill in the art because it merely changes the wall from a unitary structure into plural structures.

Art Unit: 3763

Claims 16, 17, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubrul as applied to claims 1 and 34 above, and further in view of DAVEY (US Patent No. 6,432,091). Dubrul discloses the claimed invention except for a distal end with flexible seal to form a seal around a guidewire. Davey teaches a distal end with flexible seal to form a seal around a guidewire (figs. 5, 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Davey in the invention of Dubrul in order to prevent fluid from leaking into the lumen while the guidewire was in place to position the catheter.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dubrul as applied to claim 34 above, and further in view of SAVAGE et al. (US Patent No. 6,669,679). Dubrul discloses the claimed invention except for holes angled proximally on a catheter shaft. Savage teaches holes 42 angled proximally on a catheter shaft (fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Savage in the invention of Dubrul to reduce or eliminate recoil and/or whipping motions of the catheter body during injection procedures.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (703) 305-5873. The examiner can usually be reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi, can be contacted at (703) 308-2698. The fax number for submitting official papers is (703) 872-9306.

Art Unit: 3763

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjh  
12 October 2004

A handwritten signature in black ink, appearing to read "M J Hayes", with a stylized flourish at the end.

**MICHAEL J. HAYES**  
**PRIMARY EXAMINER**